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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,997	10/04/2005	Kai Schiemann	MERCK-3071	6470
23599 7590 06/29/2010 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER MURRAY, JEFFREY H				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
06/29/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

DETAILED ACTION

Status of Claims

Claims 1-11, 13, 15, 17 and 19 are pending in this application. Claims 12, 14, 16 and 18 have been cancelled. This action is in response to the applicants' filing of an after final amendment on May 25, 2010.

Withdrawn Rejections/Objections

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

Claim Rejections - 35 USC § 112, 1st paragraph

Claim 17 remains rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of treating depression, strokes, cerebral ischaemia, extrapyramidal motor side effects of neuroleptics and of Parkinson's disease, Alzheimer's disease, amyotrophic lateral sclerosis, obsessive-compulsive disorder, tardive dyskinesia, does not reasonably provide enablement for any other diseases or disorders stated within the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicants have corrected examiner's statement that "method claims" are per se functional, and do not include inoperative embodiments. Examiner disagrees that these method claims are *per se* functional with regards to these diseases/disorders. While there may be select diseases/disorders that applicants can show are treatable with the

direct correlation of %-HT_{1A} inhibition, the applicants have not provided any documentation as to what these specific diseases or disorders are.

Applicants also argued that post-filing date publications can show that one of ordinary skill in the art could have practiced the invention as of the filing date without undue experimentation. Applicants cite case law to support their position. Examiner has reviewed the case law and it is not on point. *In re Brana* discusses the "utility" of an invention, not the enablement. *Amgen v. Hoeschst Marion Roussel, Inc* discussed whether a post-filing date publication could be used by an "expert" in testimony to show the extent of the enabling disclosure. Finally, *Plant Genetic Systems N.V. v. Dekalb Genetics Corp.* states that a post filing document can only be used to show the state of the art "at the time of filing." As none of post-filing date publications provided by the applicants shows the state of the art "at the time of filing" they are not relevant documents.

As previously stated, the claims are to be interpreted in their broadest reasonable interpretation. Examiner need only look at the list of diseases that applicants claim are "treatable" to determine that several diseases are not enabled. For example, several types of brain or spinal cord trauma are untreatable. One would not envision a spinal cord-related paralysis to be treatable by an increase in serotonin levels. Nor would one ordinarily skilled in the arts expect all the different sleeping disorders, eating disorders, learning disorders, memory disorders or sexual dysfunction/disorders to be treatable generally. These are merely categories of diseases and disorders. Each category contains several different types of diseases or disorders wherein each is unique. Some

are biologically based while others are psychologically based. For example, one ordinarily skilled in the art would not expect the same results treating "night terrors" as they would narcolepsy. Applicants may view the documents supplied with this action which several of the various diseases and disorders associated with brain or spinal cord trauma, sleeping disorders, eating disorders, learning disorders, memory disorders or sexual dysfunction/disorders. No new matter permitted. Appropriate correction is required.

Allowable Subject Matter

Claims 1-11, 13, 15 and 19 are allowed.

Claims 1-11, 13, 15 and 19 are free of the prior art. No prior art is seen which contains compounds of Formula I in the current application's claim 1.

Conclusion

Claims 1-11, 13, 15 and 19 are allowed.

Claim 17 is rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/
Patent Examiner , Art Unit 1624

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**